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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,013	07/10/2001	Wei-Sing Chu	2313-117	8860

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EXAMINER

CHIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/901,013

Applicant(s)

Chu

Examiner

Chris L. Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 10, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-83 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a.) The status of the parent application recited in page 1 of the specification needs to be updated.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

2. Claims 80-83 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide adequate written description of the robotic system recited in claims 80-83. Page 9 of the instant specification discloses that Figure 7 represents a system showing four solutions, each in a different container. The complete system of tissue, ultrasound generator, transducer, sensors, and CPU can be moved from one container to the next. The robotic system that controls the movement of the components in Figure 7 is not shown. Figures 6A and 6B show block diagrams of the robotic system that is to be used in Figure 7. However, there is no specific description of the components that comprise the robotic system

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of Figures 6A and 6B in the instant specification. Example 7 on page 29 of the specification discusses the sensors, transducers, CPU, etc shown in Figures 6A and 6B but there is no detailed disclosure of the robotic system that is required to move sample or tissue and an ultrasound transducer as recited in claims 80-83.

3. Claims 80-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 80 is confusing. While the preamble of the claim recites a “robotic system” the body of the claim only recites a single component and thus does not recite a complete “system” as required by the preamble.

Claims 80-81 are vague and indefinite. It is noted that claims 80-81 recite “means plus function” language which is acceptable if the specification provides the necessary disclosure to define the means recited in the claims. The instant specification provides no disclosure that defines the “means for moving a sample or tissue and an ultrasound transducer from a first reaction chamber to a second reaction chamber” as recited in claim 80 or the “means for moving one or more sensors from said first reaction chamber to said second chamber”. Without adequate disclosure in the specification to define the means recited in claims 80-81, the metes and bounds of the claims cannot be determined nor is it possible to ascertain what these means are.

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Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 80-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Roginski.

Roginski (US Patent 4,927,545) discloses a computer controlled apparatus with a robotic arm that can transport test tubes from one position to another (col. 4).

The apparatus of Roginski is not disclosed for moving a sample or tissue, an ultrasound transducer, or one or more ultrasound transducer from a first reaction chamber to a second reaction chamber. However, since the “means” recited in claims 80-81 are not clearly defined, the computer controlled apparatus and robotic arm of Roginski is considered to read on the instantly claimed “robotic system”.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 10:00 am to 7:30 pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc
June 3, 2003



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/641
6/3/03